

REMARKS

Claims 1-13, 18 and 21-32 are pending in this patent application.

1. Alleged Obviousness-Type Double Patenting

Claims 1-13, 18, and 21-32 stand rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-25 of U.S. Patent No. 6,369,209 ("the 209 patent") in view of Damha, *et al.*, *Bioconjugate Chemistry*, 1999, 10, 299 ("the Damha reference"). Applicants respectfully request reconsideration of this rejection because neither the 209 patent claims nor the Damha reference so much as suggests the claimed oligonucleotides.

The Office Action notes that claim 1 of the 209 patent is directed to oligonucleotides containing a first portion of nucleotides having B-form conformational geometry and a further portion of nucleotides having A-form conformational geometry, wherein at least two of the nucleotides of the first portion are arabinonucleotides.

Arabinonucleotides are not ribonucleotides, however, and it appears to be for this reason that the Office Action acknowledges a failure of disclosure in the 209 patent claims with respect Applicants' claimed subject matter. Specifically, the 209 patent claims do not mention the "at least two ... ribonucleotides" limitation of instant claim 1.

The Damha reference, however, does not remedy this deficiency. Indeed, the Damha reference has not been relied upon for any disclosure relating to ribonucleotides. Rather, the Office Action appears to assert that the Damha reference teaches the advantages of arabinonucleotides, and thus would have motivated those of ordinary skill to include more than two arabinonucleotides in the oligonucleotides claimed in the 209 patent. Significantly, however, disclosure relating to Applicants' "at least two ... ribonucleotides" limitation would still have been lacking.

Since neither the 209 patent claims nor the Damha reference teach or suggest the claimed oligonucleotides, Applicants request that the rejection for alleged obviousness-type double patenting be reconsidered and withdrawn.

2. Alleged Anticipation

Claims 1-3, 5-9, 18, and 21-29 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 5,670,633 ("the 633 patent"). According to the Office Action, the 633 patent claims disclose an oligonucleotide having covalently-bound nucleosides that individually include a ribose or deoxyribose sugar portion and a base portion, wherein at least two of the nucleosides include a modified deoxyfuranosyl moiety bearing a 2'-fluoro substituent (Office Action at pages 4-5). The 633 patent claims, however, do not mention Applicants' claimed structure. For example, they do not teach or suggest placing in a single oligonucleotide both: (1) "a first portion of ... nucleotides [that] have B-form conformational geometry ..., at least two of said nucleotides of said first portion being ribonucleotides," and (2) "a further portion of ... nucleotides [that] are ribonucleotide that have A-form conformation geometry." Accordingly, the rejection for alleged anticipation is improper and should be withdrawn. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631 (Fed. Cir. 1987) (claim is anticipated only if each and every element set forth in the claim is found in a single prior art reference).

3. Alleged Obviousness

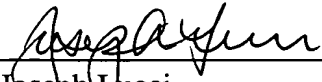
Claims 1-3, 5-9, 18, and 21-29 stand rejected under 35 U.S.C. §103(a) because the claimed subject matter allegedly would have been obvious to persons of ordinary skill in view of the 633 patent. The Office Action, however, fails to address such key issues as: (1) why such persons would have been motivated to modify the disclosure of the 633 patent; (2) what modifications, if any, they would have been motivated to make, and (3) how such modifications would have led them to one of Applicants' claimed inventions. Accordingly, the rejection for alleged obviousness is improper and should be withdrawn. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) ("examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed").

DOCKET NO.: ISIS-4789
Application No.: 09/970,971
Office Action Dated: March 12, 2004

PATENT

In view of the foregoing, Applicants submit that the claims presently before the Examiner are in condition for allowance. An early Office Action to that effect is, therefore, earnestly solicited.

Date: June 4, 2004



Joseph Lucci
Registration No. 33,307

Woodcock Washburn LLP
One Liberty Place - 46th Floor
Philadelphia PA 19103
Telephone: (215) 568-3100
Facsimile: (215) 568-3439